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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/168,072	10/08/98	MARCHESANI	N 2413 ^W 101A

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QM22/0815

EXAMINER

PIERCE, W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/168,072

Applicant(s)

Marchesani

Examiner

William M. Pierce

Group Art Unit

3711



☒ Responsive to communication(s) filed on Jun 5, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Jun 5, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

WILLIAM M. PIERCE
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, 11, 12, 19, 20, 22, 23, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Potter et al. '295 as set forth in the previous office action.

In Potter the "hi" hand is determined using standard poker hierarchy and the "low" hand is determined using Lowball Poker ranks.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 6-10 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Shen.

Many variations of high/low games are known. Shen teaches a variation of a high/low wagering game that deals four cards split into two pairs of two would have been an obvious

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matter of design choice. Paying for extra and replacement cards in poker type wagering games, as called for in claim 6, is an old step. Malek is an example of one such payment in his element 11. With regards to claim 9, the amount charged is considered an obvious matter of choice. The odds payed and commissions charged are obvious matters of choice which depend upon the amount of player interest and monies generated by the game. Poker games with only single ante wagers allowed, as called for by claim 10, are old. When a dealer can draw, as called for in claim 13, and the number of cards dealt as called for in claims 14-16 are an obvious matter of choice not shown to be critical to the game by solving any particular problem or producing any unexpected results. As to claims 17 and 18, Player/banker formats to wagering games are old in order to eliminate the house participation. Note Wolf.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Banyai.

To have provided a bonus award dependent upon the meld of a players hand would have been obvious as taught by Banyai in order to increase player interest.

6. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Lo.

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Potter's layout fails to show indicia to the play of the game. It is old to provide indicia relating to the play of the game on the layout in order to remind them. Lo shows this by way of example.

In applicant's remarks he first asserts that for "the rejections made in the Office Action to be valid" the assumption that applicant's invention must be the same as in Breeding. However, this is not true since applicant's invention is based on his claimed invention. In short, this logic defies conventional patent practice.

He goes on to state that one difference is that Breeding deals 7 cards and that any number of cards between 3 and 7 can be dealt according to claim 1 of his invention. This position is false since claim 1 specifically calls for "an equal number of cards being dealt to each player, said equal number being from 3 to 7. Within the scope of claim one Breeding deals 7 cards which is "an equal number...from 3 to 7". As such Breeding meets this limitation in claim 1 contrary to applicant's contention.

Applicant goes on to state that the scoring between the games is different as "the specification makes clear". As set forth above the Breeding is interpreted based on applicant's claims and subject matter in the specification will not be read into the claimed invention. As such, failing to point to any particular limitations in the claims where the scoring of the two game are different, this argument has little merit.

Next remark in attempt to distinguish over Breeding is that he "does not teach or suggest any variation of this dealing and playing methodology". Claim 1 calls for "having each player split

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at least three of their respective cards into (two hands) half-hands". Nowhere in the claims does it recite that these hands are of equal amount. No such limitations will be read into the claims from the specification. This is exactly what is done with Breeding where seven cards (which is "at least three") are split into two hands, one high and one low. Hence, even with respect to this argument, Breeding clearly meets the limitations of the claims.

Applicant argues examiners findings of obviousness for the winning scheme by stating that "one skilled in the art" is "the dealer". Such is not true. One skilled in the art is anyone familiar with the play or design of games. A winning scheme is nothing more than a predetermine criteria that must be met by a player in order to be considered a winner. While a change in design may make the games different, the games may not be patentably distinct as in the instant case. For example, in poker, merely changing the type card combinations and their rankings does not make a patentably distinct poker game. In conclusion to this issue, examiner refers back to his position in the previous office action rather than restate it here again.

A mere allegation that secondary references are not combinable does not distinguish over the applied art of record. As replied to above the splitting of the cards in the instant invention is not distinguished in the claims from what is fairly taught in the applied art.

Applicant argues in favor of claims 6 and 12 that Malek is a combination 21 baccarat game and is therefore not combinable. Such a rationale is not persuasive. Malek teaches in banking type card games in general (like the instant invention) that buying an extra card is known. Thus the combination is considered proper.

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.



**WILLIAM M. PIERCE
PRIMARY EXAMINER**